R_1 is hydroxyalkyl, substituted or unsubstituted phenylamino, unsubstituted benzyl, alkoxyalkyl, hydroxyalkoxyalkyl, hydroxypoly(alkoxy)alkyl, or aminoalkyl;

and, instruction for use in treating cancer or a viral infection.

REMARKS

I. Status of Claims

Claims 5, 6, 12, 16-19, and 21-24 are canceled. Claims 1, 2, 4, 7, 8, 11, 20 and 25 are amended. Claims 1-4, 7-11, 13-15, 20, and 25 are pending.

II. Objection to the Specification

The disclosure was objected to for having two "Tables 4."

Response

The first "Table 4" at page 18 and reference thereto at page 17 have been amended to be labeled as "Table 3A." Applicant believes this amendment obviates this objection to the specification and requests that the objection be withdrawn.

III. Claim Objections

Claims 6, 8, 11 and 17 were objected to because of informalities regarding "which" in claims 8 and 11 and "enhanced" in Claim 17. Claim 6 is dependent upon itself. Further, Claim 7 and 19 were found to be identical in scope.

Response

Claim 6 is canceled. Claims 2, 4, 8, and 11 have been amended to replace "which" with language that has antecedent support. Claims 17 and 19 have been canceled.

IV. Priority

The Office Action states that certain moieties for R1 have support in the parent application 08/857,811. However, remaining moieties for R1 do not have support, therefore, the claims are treated as having an effective filing date of September 29, 2000. An intervening art rejection may be overcome by cancelling the relevant claim limitations or submitting an affidavit under 1.131.

Response

Where R is haloalkyl, cycloalkyl, alkoxy, or alkenyl has been removed from the claims.

V. Rejection of Claims under §102

The Office Action states a rejection of Claim 1 under 102(b) as being anticipated by Agarwal *et al.* or Ram *et al.*, a rejection of Claims 7, 19, and 20 under 102(b) as anticipated by Naim *et al.*, and a rejection of Claims 1-4, 7-11, 13, 17-20, and 22 under 102(e) as anticipated by Camden '862.

Response

Claims 17-19 and 22 are canceled. The invention as now claimed is not disclosed in Agarwal *et al.*, Ram *et al.*, Naim *et al.*, or Camden '862 and therefore is not anticipated under §102(b) or §102(e). Applicants request that this rejection be withdrawn.

VI. Ownership of Claimed Invention

The subject matter of the claims was commonly owned at the time the claimed invention was made.

VII. Rejection of Claims under §103(a)

Claims 2-16 and 19-25 were rejected as unpatentable over Agarwal *et al.* or Ram *et al.* Claims 17-18 were rejected under 103(a) as unpatentable over Ram *et al.* Claims 8-16 and 21-25 were rejected as unpatentable over Naim *et al.* Claims 5, 12, 14, 15, 21, 23, 24, and 25 were rejected as unpatentable over Camden '862.

Response

Claims 5, 6, 12, 16-19, and 21-24 are canceled. A difference in the prior art and the claims at issue is the substituents on the benzimidazole portion of the claimed compound.

The Federal Circuit has required that specific support must be found in the prior art that "suggests" or "teaches" the modification necessary to resolve the differences of the prior art with a claimed invention. *In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985). Applicants submit that no such support for making the structural and chemical changes to the compounds of Agarwal *et al.*, Ram *et al.*, Naim *et al.*, or Camden necessary to resolve the differences with the claimed invention is present in any of the cited references, or combinations thereof. Applicants respectfully request that this rejection be withdrawn.

VIII. Provisional Obviousness-Type Double Patenting

Claims 1-25 were provisionally rejected under the judicially created obviousness-type double patenting as unpatentable over Claims 1-5, 10, 21-25, 30, 34-36 of copending 08/857,811.

Response

A terminal disclaimer (Attachment B) is submitted herewith which obviates this rejection. According to the MPEP at section 804.02, the filing of a Terminal Disclaimer simply serves the statutory

function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.

In view of the above, it is respectfully requested that the obviousness-type double patenting rejection be withdrawn.

IX. Information Disclosure Statement

Provided herewith are copies of all nonpatent art listed in the PTO-Form 1449 mailed October 30, 2000 in the present case.

The present application claims priority to copending USSN 08/857,811 (P&G No. 6643). Included herewith are copies of pending applications listed in the PTO-Form 1449 mailed October 30, 2000 in the present case that were not provided in the parent application USSN 08/857,811. Copies of the pending applications cited in the 1449 form mailed July 14, 2000, in that parent case, were forwarded on June 22, 2001 to the Examiner for USSN 08/857,811 concurrently with filing a Request for Continued Examination requesting that they be made of record.

Applicants note that the requirement for submission of copies of pending applications did not go into effect until November 7, 2000. Therefore, Applicants are believed not to have been under an obligation to provide copies of pending applications on October 30, 2000 when the IDS was filed. Applicants respectfully request that the Examiner make the references of the October 30, 2000 Information Disclosure Statement of record.

X. Conclusion

It is believed that all matters of the Office Action have been addressed. Reconsideration and an early indication of the allowability of the claims are earnestly requested. Should the Examiner have any questions, comments or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (512) 499-6200.

Respectfully submitted,

Gloria L. Norberg

Date: January 29, 2002

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ATTACHMENT A
VERSION WITH MARKINGS TO SHOW CHANGES MADE
(language to be added is underlined and language to be deleted is enclosed in brackets)

In the Specification

At page 16, the second paragraph is amended as indicated below:

DNA-interactive agents include alkylating agents, *e.g.*, cisplatin, cyclophosphamide, and altretamine; DNA strand-breakage agents, such as bleomycin; intercalating topoisomerase II inhibitors, *e.g.*, dactinomycin and doxorubicin[)]; nonintercalating topoisomerase II inhibitors, such as[,] etoposide and teniposide; and the DNA minor groove binder [plicamydin] plicamycin, for example.

At page 17, the paragraph beginning at line 29 is amended as indicated below:

A listing of currently available chemotherapeutic agents according to class, and including diseases for which the agents are indicated, is provided as Table 3A [4].

At page 18, the title to the table is amended as indicated below:

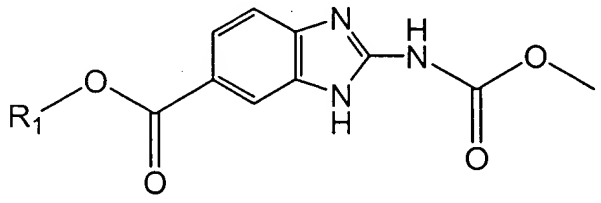
Table 3A [4]. Neoplastic Diseases[1] for which Exemplary Chemotherapeutic agents are Indicated

In the Claims

Claims 5, 6, 12, 16-19, and 21-24 are canceled.

Claims 1, 2, 4, 7, 8, 11, 20, and 25 are amended, as indicated below:

1. (2nd Time Amended) A compound of the following formula **A-3**:



A-3

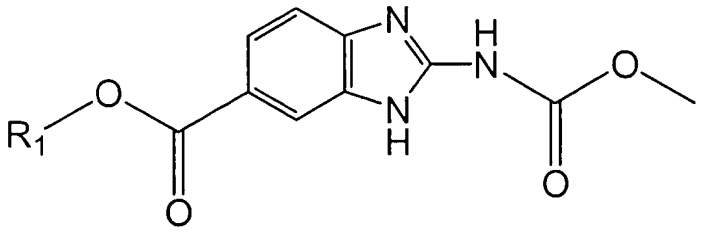
wherein,

R_1 is [haloalkyl,] hydroxyalkyl, [haloalkenyl, heterocycloalkyl, unsubstituted phenyl,] substituted or unsubstituted phenylamino, unsubstituted benzyl, alkoxyalkyl, [poly(alkoxy)alkyl,] hydroxyalkoxyalkyl, hydroxypoly(alkoxy)alkyl, [haloalkoxyalkyl, halopoly(alkoxy)alkyl,] or aminoalkyl.

2. (Amended) A compound according to claim 1 [which] wherein the compound is in the form of a pharmaceutically acceptable salt thereof.

4. (Amended) A compound according to claim 1 [which] wherein the compound is in the form of a prodrug thereof.

7. (Amended) A pharmaceutical composition comprising a therapeutically effective amount of a compound of the following formula **A-3**:



A-3

wherein,

R_1 is [alkyl, haloalkyl,] hydroxyalkyl, [alkenyl, haloalkenyl, cycloalkyl, cycloalkalkyl, heterocycloalkyl, heterocycloalkalkyl, substituted or unsubstituted phenyl,] substituted or unsubstituted phenylamino, [substituted or] unsubstituted benzyl, alkoxyalkyl, [poly(alkoxy)alkyl,] hydroxyalkoxyalkyl, hydroxypoly(alkoxy)alkyl, [haloalkoxyalkyl, halopoly(alkoxy)alkyl,] or aminoalkyl;

and, a pharmaceutically acceptable carrier.

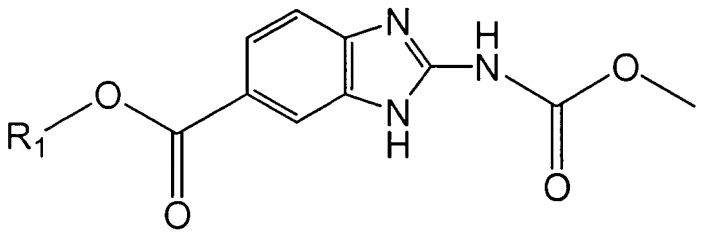
8. (Amended) A pharmaceutical composition according to claim 7 [which] wherein the compound is in the form of a pharmaceutically acceptable salt thereof.

11. (Amended) A pharmaceutical composition according to claim 7 [which] wherein the compound is in the form of a prodrug thereof.

20. (Amended) A composition [unit dosage form] according to claim 7 [19] which comprises from 1 mg to 1000 mg of said compound.

25. (Amended) A pharmaceutical kit comprising:

a therapeutically effective amount of a compound of the following formula **A-3**:



A-3

wherein,

R_1 is [alkyl, haloalkyl,] hydroxyalkyl, [alkenyl, haloalkenyl, cycloalkyl, cycloalkalkyl, heterocycloalkyl, heterocycloalkalkyl, substituted or unsubstituted phenyl,] substituted or unsubstituted phenylamino, [substituted or] unsubstituted benzyl, alkoxyalkyl, [poly(alkoxy)alkyl,] hydroxyalkoxyalkyl, hydroxypoly(alkoxy)alkyl, [haloalkoxyalkyl, halopoly(alkoxy)alkyl,] or aminoalkyl;

and, instruction for use in treating cancer or a viral infection.